

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	: François Girard et al.)	
Appln. No.	: 10/570,347)	Group Art Unit 3618
Docket No.	: P29468)	Examiner Katy Meyer
Customer No.	: 07055)	Confirmation No. 5450
I.A. Filed	: September 1, 2004)	
Title	: Cross-Country Ski System)	
	Provided with a Direct)	
	Bearing Lateral Surface)	

ARGUMENTS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

U.S. Patent and Trademark Office
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Alexandria, VA 22314

Sir:

Pursuant to the Official Gazette Notice published on July 12, 20005, entitled "New Pre-Appeal Brief Conference Pilot Program," Applicants herewith present arguments which accompany a completed and signed form PTO/SB/33, entitled "Pre-Appeal Brief Request for Review."

Also filed herewith are a Notice of Appeal, pursuant to 37 CFR § 41.31, and payment of the appeal fee, pursuant to 37 CFR § 41.20.

ARGUMENTS

To be withdrawn are (1) the rejection of claims 8-15, 17-47 under 35 USC § 103(a) over Callegari (U.S. Patent No. 5,108,125) in view of Bejean (U.S. Patent No. 5,333,890), and (2) the rejection of claim 16 under 35 USC §103(a) over Callegari in view of Bejean and Kenney (U.S. Patent No. 6,257,620).

A. Summary of the Invention

The invention is directed to a ski and for a ski "system" (i.e., a ski with binding), particularly of the Nordic or cross-country type, in which the front of the skier's boot is attached to the ski while allowing the heel to be raised and lowered alternately as the skier strides relative to the snow.

The invention is more specifically related to an improvement in the ski and binding in the context of modern-day equipment, whereby the attachment of the boot relative to the ski is *beneath* the front of the boot, such as at the metatarsophalangeal bending zone of the foot, rather than being *forward* of the front of the boot. As explained in paragraph 0007 of Applicants' specification, in spite of the advantages provided by locating the attachment of the boot beneath the boot, a particular disadvantage is thereby created, namely, the binding is required to interpose a plate between the boot and the top of the ski. In raising the boot relative to the ski, control of the ski is adversely affected, the skier no longer having as precise control over the ski.

The invention, therefore, provides a ski and a ski system in which the skier's boot is directly supported on the top surface of the ski despite it being attached to the ski *beneath* the boot. In this regard, see Fig. 4, e.g., in which the binding device 12 is shown schematically (Fig. 1 shows the binding device in greater detail), being situated within a recess 29 formed in the top of the ski, thereby exposing upper surfaces 28 for direct support with the sole of the boot, as explained in paragraph 0016.

In short, Bejean '890 does *not* disclose an open recess in the upper surface of a ski, and does *not* teach placing a binding in an open recess in the upper surface of a ski. Accordingly, the rejections should be withdrawn.

B. Withdrawal of Rejection Based Upon Callegari + Bejean '890

Applicants request withdrawal of the § 103(a) rejection based upon the combination of Callegari and Bejean '890 at least for the reasons of record. See, e.g., Applicants' comments in Section C of their Remarks, beginning on page 17 of their reply (filed June 27, 20110) to the Office action of March 30, 2011.

Below is an abbreviated version of those comments, in addition to the citation of a decision of the Board of Appeals and Interferences in *Ex parte Peoples*, No. 2010-007842 (B.P.A.I. Sept. 29, 2010), in which the board reversed a rejection from Technology Center 3600, that rejection having been based upon analogous reasoning.

Callegari discloses a ski binding (which he refers to as an *attachment* for a cross-country ski) that "is fitted to a cross country ski 34 above the upper support surface 35 of that ski 34" (see column 4, lines 53-54). By contrast, Applicants' claimed ski – shown in Figs. 3 and 4, for example – is configured to have the binding fitted *below* the upper support surfaces (such as below boot-engaging surfaces 28).

Further, Callegari's binding/attachment includes a front body 27 and a rear body 29 (which are parts of an "oscillatory connector" 26) which fit within a downwardly open "seating" 19 in the front of the sole 18 of the boot, the front and rear bodies 27, 29 engaging anchorage pins 20, 21 of the front of the sole, the front and rear bodies being pivotable (during skiing) about the pivot 12 (which extends between, and is mounted to, transversely spaced-apart wings 36 (see Fig. 4)), the pivot 12 extending through the front body 27. The binding/attachment is fixed at its front to the ski with a screw 15, which extends through support 11, and at its rear by means of screws (see Fig. 4) extending through a transverse bracket 13, the latter forming a seating 38 for receiving a connection plate 16 of the support 11 (see column 6, lines 32-34), which could be "sunk" in the ski.

The final sentence of the large paragraph on page 2 of the Office action explains that *"Callegari does not disclose a recess in the upper surface of the ski."*

And Bejean '890 does not disclose a recess in an upper surface of a ski.

Bejean '890 also fails to disclose a binding and fails to disclose a recess in a ski for receiving a binding. Like Bejean '179, relied upon in the prior Office action (of May 26, 2010) and then withdrawn, Bejean '890 is only directed to the ski itself whereby, with reference to Fig. 5, the upper and lower elements 4, 5 are joined. That is, *Bejean '890 says nothing relating to the mounting of a binding on a ski.*

The advantage of Bejean '890's invention, referenced on page 3, lines 2-4, of the final Office action – facilitating manufacturing and the selection of "desired performance characteristics" – is irrelevant to the mounting of Callegari's binding to a ski. Bejean's disclosure is limited to creating skis with different performance characteristics by varying the type of top element that is mated with a bottom element, both elements extending the length of the ski, or substantially so (column 4, lines 38-41). The nesting of the top element into a longitudinal groove of the bottom element facilitates the manufacture *of the ski* (see column 3, lines 48-56) and facilitates the achievement of varied mechanical response characteristics *of the ski* (see column 3, lines 40-47; column 1, lines 28-33). No evidence is offered in the rejection that these advantages relate to the mounting *of a binding* (such as that of Callegari or otherwise) on a ski – or on a bottom part of a ski. Applicants submit that a prima facie case of obviousness thus fails.

Neither Bejean '890 nor Callegari recognizes the problem addressed by the claimed invention. In this regard, neither Bejean '890 nor Callegari teaches the construction of a ski which provides for the lowering of the boot or the lowering of a binding mounted on the ski, which improves the skier's stability during use of the ski. Further, Bejean '890 says nothing, nor is there evidence that one skilled in art would have recognized anything from the Bejean disclosure, that relates to how a binding can be mounted on a ski. These are problems about which Bejean is not concerned.

In short, the final rejection has not established a reason based on the evidence in the record for combining Bejean '890 with Callegari to result in a ski according to the claimed invention, such as a ski having an upwardly facing recess (and, more particularly, a ski having an upwardly facing *open* recess) that extends downwardly to a depth below the upper boot-supporting surface.

In contrast, Callegari's disclosure is directed to a problem relating to cross-country ski bindings, particularly the problem of guiding the skier's boot during the phase of skiing when the heel is separated from the ski. The height of the skier's boot and binding relative to the snow is not addressed. Bejean's disclosure is directed to a problem relating to the manufacture of skis having different mechanical characteristics by connecting any of a plurality of upper ski-length elements having different characteristics to a common bottom ski-length element.

Lines 13-17 of page 5 of the final Office action offer the following in support of the rejections based upon Callegari and Bejean '890:

[T]he teachings of Bejean are relied on only to show a method of assembling an upper ski element and a lower ski element by nesting said upper ski element in a recess formed in said lower ski element. If one were to apply this assembly method to the binding device (i.e. upper ski part) and ski (i.e. lower element), then one would arrive at applicant's invention.

Even if Bejean '890's deconstructed ski – merely the bottom – were to possess an upwardly facing recess during manufacture, i.e., a pre-formed element, the rejection has not established through evidence that, at the time of the invention, it would have been desirable to have a ski with an upwardly facing open recess that extends downwardly to a depth below the upper boot-supporting surface. *Bejean '890's upper ski element is not a ski binding. See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) ("A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.")

Applicants further take issue with the following sentence (on page 5, lines 17-19, of the final Office action), immediately following the passage quoted above:

Furthermore, one of ordinary skill in the art would have recognized the desirability of forming the recess with only the size and length necessary to accommodate the binding device.

That one skilled in the art would have recognized that is nowhere evidenced in the record. The statement is merely conclusory. Also conclusory is every one of the sentences beginning at line 16 of page 17 of the final Office action following the heading "Response to Arguments."

Applicants respectfully request that the rejections requested to be reviewed herein be considered in light of the decision *Ex parte Peoples*, No. 2010-007842 (B.P.A.I. Sept. 29, 2010), in which the board reversed a rejection from Technology Center 3600, which had been based upon analogous reasoning.

The rejection at hand, analogous to the rejection reversed in *Peoples*, articulates no reason why one of ordinary skill in the art would have modified a ski used by Callegari to include a recess of a ski of Bejean despite the difference in functions of the recited prior art elements. See lines 28-32 of page 5 of *Peoples*.

C. Withdrawal of Rejection Based Upon Callegari + Bejean '890 + Kenney

Applicants request withdrawal of the § 103(a) rejection of claim 16 based upon the combination of Callegari, Bejean '890, and Kenney for the reasons presented near the bottom of page 15 of their reply filed on February 12, 2010. Although the primary references relied upon in the earlier rejection differ, Kenney is deficient in teaching a modification of Callegari + Bejean '890 for the same reasons.

D. Conclusion

For the foregoing reasons, withdrawal of the rejection is kindly requested.

Respectfully submitted,

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